

REMARKS

Claims 1-36 remain pending in this application.

Claim Rejections -- 35 U.S.C. § 103

Claims 1-6, 10-15, 19-24, and 28-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,751,286 to Barber et al. (hereinafter "Barber") in view of U.S. Patent No. 6,014,581 to Whayne et al. (hereinafter "Whayne").

This rejection is respectfully traversed.

Applicant respectfully submits that Barber and Whayne, when taken alone or in combination with one another, fail to disclose or reasonably suggest the combination of features set forth in the independent claims of the subject application.

The inventions as defined in claim 1 is directed to computer software-mediated method for annotating an image aspect of an electronic image. Claim 1 recites a method comprising steps of displaying an electronic image, permitting a user to access and query a first searchable electronic database of annotations, and associating an annotation of the first searchable electronic database with an image aspect of the electronic image. As set forth in claim 1, the "annotation" is displayed positioned in the electronic image to permit the user to identify the associated image aspect of the displayed image. For example, if the displayed image depicts four (4) people, the annotation might comprise a name of one of the people positioned to permit identification of the person. As further set forth in claim 1, after the annotation is associated with the electronic image, the annotation association is stored in a second searchable electronic database so as to permit a user to

retrieve the electronic image by querying the second electronic database for the annotation.

As acknowledged by the Examiner at page 3 of the final Office Action, Barber and Whayne fail to disclose a second searchable electronic database that allows a user to search and retrieve electronic images by querying the second electronic database for the annotation. Despite the absence of this claim element in the prior art, the Examiner asserted the rejection, alleging that this missing claim feature is “an obvious detail implementation:”

The use of a second database in which associated annotations could be stored in would have been an obvious detail implementation depending on design preference. For example, in a network environment, annotations and the images could be all stored on a server, or the annotations could be stored on the client while the images could be stored on the server. These variations on the implementation could be applied depending on preference without affecting the functionality of database querying.

The courts have established that 35 U.S.C. § 103 obviousness is a question of law based on findings of fact relating to the prior art, the skill of the artisan, and objective considerations. See *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). A rejection of claims under 35 U.S.C. § 103 requires that the Examiner set forth a *prima facie* case of obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In order to set forth a *prima facie* case of obviousness based on a combination of references, the Examiner must have some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). In determining motivation, the Examiner may rely on the teachings of the references themselves, their relatedness to the field of the applicant's invention, and the knowledge of persons of ordinary skill in the field of the invention.

See *In re Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1445-46; *In re Gorman*, 933 F.2d at 986-87, 18 USPQ2d at 1888; *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). However, the Examiner may not reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor. *Interconnect Planning Corp v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Rather, the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination. *Fromsom v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985). Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention, which is an illogical and inappropriate process by which to determine patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

Measuring a claimed invention against the standard established by § 103 requires the difficult, but critical, step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 UPSQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is particularly important where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of

a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.*

Applicant respectfully submits that the Examiner has violated several of these axioms in fashioning the Section 103 rejection.

First, the Examiner alleges that use of the claimed second database "would have been an obvious detail implementation depending on design preference." However, the Examiner has not pointed to a prior art reference of record that teaches a searchable electronic database for permitting a user to retrieve the electronic image by querying the electronic database for the annotation associated with the electronic image. The only document of record mentioned in the final Office Action that describes this feature is the subject patent application itself. It is impermissible to use the disclosures of the subject application as building blocks for an obviousness rejection.

Second, even assuming *arguendo* that the second database of claim 1 is disclosed in the applied prior art, which it is not, there is no teaching, suggestion, or motivation in the art for combining such fictitious disclosure with Barber and Whayne. The prior art does not suggest to one of ordinary skill in the art the desirability of the combination claimed in claim 1. The absence of a citation to such prior art motivational teaching is conspicuously missing from the final Office Action. Rather, the Examiner attempts, inappropriately, to circumvent the motivational-teaching requirement by characterizing the claimed second database as "an obvious design implementation." Applicant respectfully disagrees with the Examiner's characterization of the claimed feature, especially in the context of the overall claimed invention. The prior art nowhere describes a searchable electronic database that permits annotation querying of electronic

images as either “obvious” or a “design implementation.” Further, Applicant is unaware of any case law that excuses the motivational requirement where the claimed feature is an alleged “design implementation.”

Third, in the final Office Action the Examiner states, without any support or basis in the prior art, that “in a network environment annotations and the images could be stored on a server, or the annotations could be stored on the client while the images could be stored on the server. (Emphasis added). Applicant respectfully points out that this is the classic “obvious to try” scenario. Whereas it could have been obvious to try and create a second database in which associated annotations could be stored in order to satisfy certain “design preferences,” this is not adequate basis for a rejection under section 103.

Additionally, Applicant respectfully submits that the claimed feature of a second searchable electronic database, when taken in the context of the claimed invention, is much more than a design implementation (to the extent this undefined term is understood by Applicant). The invention recited in claim 1 is a computer software-mediated method for annotating an image aspect of an electronic image. The ability to not only annotate, but also search annotations assigned to electronic images and retrieve electronic images on the basis of their annotations, provides a powerful search and organization tool that is both highly efficient and simple to operate.

Finally, Applicant respectfully traverses this use of Official Notice. The Examiner acknowledged that neither Barber nor Whayne discloses certain features of the invention, but took Official Notice “that it is well known in the art for annotations to be created/edited and stored/saved in a searchable database which could be later displayed in a list for selection by a user.” MPEP § 2144.03 states the use of Official Notice “should

be rare when an application is under final rejection.” The present patent application is under final rejection. Thus, should the Examiner persist in relying on Official Notice, the finality of the rejection should be withdrawn.

Further, the same MPEP section proscribes the use of Official Notice to establish the state of the art:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also ...*In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art....”)

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See MPEP § 2144.03. Further, the Examiner has not pointed to any evidence of record to support the assertion of common knowledge. The Examiner has not provided specific factual findings predicated on sound technical and scientific reasoning to support his conclusion that the claimed feature is well known or of common knowledge. See *In Re Soli*, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963).

Pursuant to MPEP § 2144.04, in view of this traversal of the Examiner’s use of Official Notice, “the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko* 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some

concrete evidence in the record in support of these findings' to satisfy the substantial evidence test).”

For these reasons, Applicant respectfully submits that the Section 103(a) rejection of claim 1 should be reconsidered and withdrawn. Applicant further respectfully submits that independent claims 10, 19, 28, 31, and 34 recite identical or similar features to those discussed above with respect to claim 1 and, therefore, are allowable for the same or similar reasons.

With regard to the remaining claims, Applicant respectfully submits that each is dependent upon a corresponding independent claim and includes all of the distinguishing features thereof.

For these reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 103 rejection of claims 1-6, 10-15, 19-24, and 28-36.

Claims 7-9, 16-18, and 25-27 have been rejected under Section 103 as being unpatentable over Barber and Whayne, in view of Kuchinsky et al., FotoFile (hereinafter “Kuchinsky”).

Applicant respectfully traverses this rejection.

Claims 7-9 depend from claim 1. Claims 16-18 and 25-27 depend from claims 10 and 19, respectively. Applicant has established above that Barber and Whayne, when taken alone or in combination, fail to render claims 1, 10, and 19 unpatentable. Kuchinsky, which has been cited for their alleged disclosure of photograph labeling, does not overcome the deficiencies of Barber and Whayne. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

In view of the foregoing, Applicant respectfully submits that the pending claims are allowable and that the application is in condition for allowance. Reconsideration of the application in view of this response and its passage to issue are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule same.

This Response is being filed within three months of the date of the Office Action. Accordingly, neither a petition for extension of time nor a petition fee has been concurrently filed. If any fees are due in connection with the filing of this response, please charge Deposit Account No. 50-0548 and accept this paper as a petition for extension.

Respectfully submitted,



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